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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/890,926      | 08/07/2001  | Shinji Tanaka        | 1265-01             | 1861             |

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IP DEPARTMENT OF PIPER RUDNICK LLP  
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PHILADELPHIA, PA 19103

EXAMINER

GILLIAM, BARBARA LEE

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1752

DATE MAILED: 08/25/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/890,926

Applicant(s)

TANAKA ET AL.

Examin r

Barbara Gilliam

Art Unit

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-- The MAILING DATE f this communication appears on the c ver sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-7, 10 and 11 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment filed June 13, 2003 has been entered and fully considered.
2. Claims 2-11 are present.
  - a. The rejection of claim 1 over Igarashi et al. (US 5,168,029) is withdrawn in light of the amendment.
  - b. The objection to claims 6-9 is withdrawn.
3. The indicated allowability of claims 2-5 and 11 is withdrawn in view of the newly discovered reference(s) to JP 11-352670 A. Rejections based on the newly cited reference(s) follow.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 2-7, 10-11 are rejected under 35 U.S.C. 102(a) as being anticipated by JP 11-352670 A (translation provided).
  - a. In JP 11-352670 A, Hiroshi et al. teach an original plate for photosensitive printing comprising a support, a photopolymerisable layer and a masking layer which anticipates the photosensitive resin printing plate of the present application. The photopolymerisable layer of Hiroshi et al. comprises an elastomeric binder such as vinyl acetate [0010], [0011]. It can also contain a polyacrylamide or polyvinyl alcohol [0014].

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The layer further comprises an ethylenic unsaturated compound [0015] and a photoinitiator [0016]. Hiroshi et al. do not specifically teach the thickness of the photopolymerisable layer however the thermosensitive layer has a thickness of 125  $\mu\text{m}$  (0.125 mm) [0029] and in Example 1 [0034] the entire plate has a thickness of 2.8 mm. Therefore at most the thickness of the photopolymerisable layer is 2.675 mm. The masking layer of Hiroshi comprises at least an infrared photothermal conversion layer (B-a) which has a material which converts an infrared ray to heat and a thermosensitive layer (B-b) which becomes substantially opaque with heat at the active light ray of non-infrared rays and a cover film if necessary (claim 1). The material of the photothermal layer (B-a) can be carbon black or an infrared ray absorbing pigment or dye such as cyanine dye, which absorbs in the region of 750 – 20,000 nm [0018]. This material meets the present limitations for the photothermal-transforming substance. The thermosensitive layer comprises a leuco pigment and a color developer [0019], which meet the present limitations for the thermal color former, and the developer respectively. A production method is claimed which comprises the removal of the cover film, imagewise exposure with infrared laser light to make the mask of layer (B-b) followed by whole surface exposure through the mask with active light ray of non-infrared rays and removal of the non exposed areas through development (claim 5). The active light ray use to expose the whole surface of the plate has a wavelength of 150 – 600 nm (preferably 300- 400 nm) [0025].

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 10 is rejected under 35 U.S.C. 102(b) as being anticipated by Damme et al.

a. In US 5,922,502, Damme et al. teach an imaging element for making a lithographic printing plate comprising on a support having a hydrophilic surface, a photosensitive layer and a thermosensitive layer. The thermosensitive layer is opaque to light for which the photosensitive layer has spectral sensitivity and is capable of being rendered transparent upon exposure to laser light (claim 1). The imaging element is image-wise exposed by means of a laser thereby image-wise rendering the thermosensitive layer transparent to light for which the photosensitive layer has spectral sensitivity, overall exposing the imaging element with light for which the photosensitive layer has a spectral sensitivity and developing the imaging element (claim 11). The thermosensitive layer meets the present limitations for the photocoloring layer and the photosensitive layer meets the present limitations for the photosensitive layer.

### ***Allowable Subject Matter***

8. Claims 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

9. The following is a statement of reasons for the indication of allowable subject matter: There is no teaching or suggestion in Hiroshi et al. (JP 11-352670 A) or Damme

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US 5,922,502 of a "substance transfer-preventing layer" as required in the present application.

### ***Response to Arguments***

10. Applicant's arguments filed June 13, 2003 have been fully considered but they are not persuasive.

- a. The rejection of claim 1 in view of Igrashi et al. is withdrawn.
- b. The rejection of claim 10 in view of Damme et al. is maintained because claim 10 as amended does not specify what light the photocoloring layer is light-transmittable to. An image is formed in the thermosensitive layer when exposed by means of a laser (claim 11).

### ***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. In JP 01-133044, Uchino et al. teach a pattern forming method. The translation of this document has also been provided for Applicant's convenience.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara Gilliam whose telephone number is 703-305-1330. The examiner can normally be reached on Monday through Thursday, 8:00 AM - 5:30 PM.


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a. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter can be reached on 703-308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

b. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

*B. Gilliam*

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